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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,320	02/06/2004	Kevin S. Marchitto	D6327CIP	8525
7590	06/08/2011		EXAMINER	
Benjamin Aaron Adler ADLER & ASSOCIATES 8011 Candle Lane Houston, TX 77071			MOORE, SUSANNA	
			ART UNIT	PAPER NUMBER
			1624	
			MAIL DATE	DELIVERY MODE
			06/08/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/774,320	<b>Applicant(s)</b> MARCHITTO ET AL.
	<b>Examiner</b> SUSANNA MOORE	<b>Art Unit</b> 1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 February 2011.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9, 12-19, 22, 23 and 38-50 is/are pending in the application.  
 4a) Of the above claim(s) 2, 3, 6, 7, 18 and 40-50 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1, 4, 5, 8, 9, 12-17, 19, 21-23, 38 and 39 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I in the reply filed on 9/23/2009 is acknowledged. Group I, drawn to a composition comprising a biomolecule and a metal susceptor, embraced by claims 1-9, 12-19 and 21-30 was elected by Applicant. Applicant has not pointed to any errors in the Examiner's analysis of the classification of the different inventions. The requirement is still deemed proper and is therefore made **FINAL**.

Applicant has chosen albumin protein as the biomolecule, titanium alloy as the metal susceptor, radiofrequency as the electromagnetic energy, conformation change as the biochemical reaction specie, chemical bond involving dimer as the bond specie and tissue as the location. Applicant states the claims which read upon each specie election. The Examiner mistakenly included claims 2 and 3, which are now currently withdrawn from consideration. Thus, claims **1, 4, 5, 8, 9, 12-17, 19, 21-25, 27, 28 and 31-39** are currently under consideration.

There are 47 claims pending and 27 under consideration. Claims 2, 3, 6, 7, 18, 26, 29, 30 and 40-50 are claims drawn to a nonelected subject matter, which are currently withdrawn from consideration. The application concerns a composition comprising a biomolecule and a metal susceptor.

### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 120 is acknowledged. Applicant still has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: The later-filed application must be an application for a patent application (the parent for an invention

which is also disclosed in the prior application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). The disclosure of U.S. patent 6689380 does not mention albumin or titanium alloy, and thus, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for any claims of this application. Thus, the effective filing date of the present claims **1, 4, 5, 8, 9, 12-17, 19, 21-25, 27, 28 and 31-39** remains the immediate filing date of 2/6/04. There maybe other omissions as well.

***Specification***

The disclosure is objected to because of the following informalities: The first paragraph in the Specification should indicate **up-to-date** claims of benefit to priority U.S. Applications. Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11. Appropriate correction is required.

Applicant amended the first paragraph but did not update the information. Thus, the objection is **maintained**.

***Claim Objections***

This application contains claims 2, 3, 6, 7, 18, 26, 29, 30 and 40-50, drawn to an invention nonelected without traverse in the paper of 9/30/2009. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

Claim 9 is objected to because of the following informalities: claim 9 is not further limiting claim 1. Appropriate correction is required.

Applicant has amended claim 1 by excluding the word combination. However, a biomaterial is broader in scope than a biomolecule. Thus, the objection is maintained.

The objection of claim 24 because of claim 24 is the same in scope as claim 1 is withdrawn based on the amendments.

The objection of claims 16 and 34 because of stainless is withdrawn based on the amendments.

***Claim Rejections - 35 USC § 102***

Claims 1, 4, 5, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Klinger et. al. (J. Biomed. Mat. Res., 1998, 36(3), pages 387-393) is withdrawn.

**The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

Claims 1, 8, 9, 12-16, 19, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Burton et. al. (IEEE Transactions on Bio-medical Engineering, 1971, BME-18(2), pages 104-109).

The reference teaches albumin and stainless steel or several metal alloys, e.g. nickel-chromium, nickel-copper and nickel-palladium (see page 105, right-hand column, first full paragraph), in a composition, see page 107, left-hand column, second full paragraph. Claims 12-14 are inherent properties of the metal alloys cited in the reference. A radio frequency was applied, see page 107, left-hand column, to incur a change in state, where the albumin

coagulates, which is the start of denaturation, see page 108, bottom of left-hand column. The small genus of nickel alloys, which includes a titanium combination, on page 105, right-hand column, is anticipatory, *In re Petering*, 301 F.2d 676, 681, 133 USPQ 275, 280 (CCPA 1962).

Thus, said claims are anticipated by Burton et. al.

Claims 1, 4, 5, 8, 9, 12-15, 21-23, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Lohrmann et. al. (US 6193953).

The reference teaches compositions comprising albumin (biomolecule, columns 15-16, example 1, B), chromium (a metal susceptor, see column 16, example 4) and perfluorooctane (a therapeutic agent, column 18, example 10) in a liposome (column 18, example 9) and applying an ultrasonic field (5 MHz radiofrequency, see example 10).

Thus, said claims are anticipated by Lohrmann et. al.

Claims 1, 8, 9 and 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawin et. al. (US 5451406).

The reference teaches compositions comprising Beta-glucan (biomolecule, see column 4, line 63), zirconium oxide (a metal susceptor, see column 4, lines 60-61) in a dimension of 100 and 1000 microns, see claim 1, column 5. Furthermore, titanium alloy is mentioned in claim 3, column 5, in a small list. A genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990)

Thus, said claims are anticipated by Lawin et. al.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSANNA MOORE whose telephone number is (571)272-9046. The examiner can normally be reached on M-F 9:00-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna Moore/  
Examiner, Art Unit 1624